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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/921,141 | 08/03/2001 | Hiroshige Kikuchi | 500.40416X00 | 6408 |

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EXAMINER

JASMIN, LYNDIA C

ART UNIT PAPER NUMBER

3627

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,141

Applicant(s)

KIKUCHI ET AL.

Examiner

Lynda Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

EA

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 11, 2005 has been entered.

Amendment received July 11, 2005 has been acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims, the recitation "plurality a individual use contractors" renders the claims indefinite since it is unclear who applicants are referring to as "use contractors".

Further, in claims 21, 22, 24, 25, 32 and 34 the recitation "of the leased information electric appliances of the combined individual use contractors" renders the claims indefinite. It is unclear which leased or plurality leased information electric

appliances referred to and which combined individual use contractors referred to.

Clarification is required.

In claims 32, 34 the recitation "of the combined individual use contractors" renders the claims indefinite. It is unclear which combined individual use contractors referred to. Clarification is required.

In claim 37, the recitation "means for operating arithmetically the amount of consumed electric power from the data, and means for sending the data relating to the amount of consumed electric power thus arithmetically operated to the rent managing server" renders the claim indefinite. How does it arithmetically operated to the rent-managing server?

Regarding claim 39, the word "means" is preceded by the word(s) "measuring" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Further in claim 39, it is unclear that applicants refer to as "electric power measuring means for measuring the electric power" How is the electric power being measure?

In claim 43, the recitation "to execute the replacement judgment" lacks proper antecedent basis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

As best understood, claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mise (2002/0013723 A1), in view of Yablonowski et al. (6,535,859)

As best understood, Mise discloses an information electric appliance renting system for leasing information electric appliances to a plurality of individual use contractors, comprising: at least one information electric appliance (such as living facilities; ¶ 0024, 0025) which is leased by a service providing company (2) via service provider to respective ones of a plurality of individual use contractors (contracted customers), and a rent managing server (3) of the service providing company for

managing the leased information electric appliances (11) of the service providing company (22), wherein the at least one information electric appliance has communication means for sending including electric power consumed thereby to the data rent managing server (¶ 0042), wherein the data sent by the at least one information electric appliance to the rent managing server further includes information relating to at least one of manufacture and use of the at least one information electric appliance (such monitoring for abnormal operation; ¶ [0035]).

Mise further discloses the rent managing server includes judgment means for judging the data sent from the at least one Information electric appliance carrying out a judgment of abnormality of the at least one information electric appliance and for judging on a basis of a judgment result whether or not maintenance needs to be carried out (¶ [0010]). Further, the rent managing server includes means for generating a running pattern on a basis of the data sent from the at least one information electric appliance to compare a total cost up to a scrapping processing of the at least one information electric appliance with a total cost up to a scrapping processing of an information electric appliance which is replaceable with the at least one information electric appliance to execute the replacement judgment for the at least one information electric appliance (¶ [0079]).

However, Mise fails to explicitly disclose a managing server having communication means for receiving the data sent from the at least one information electric appliance so that the service providing company receives from the plurality of individual use contractors payment of the rent and pays an electric power company an

amount corresponding to the total consumed electric power of the leased information electric appliances of the combined individual use contractors.

Yablonowski et al. discloses the concept of charging a fee to a user where a service company services a lighting system to the user's facility. The fee is charged to the end user, such that the fee is a function of a difference between the original power consumption and the new power consumption. For example, the fee from the end user to the service company is forty cents where the original electric utility cost was one dollar (as illustrated in FIG. 1) and the new electric utility cost is sixty cents.

Yablonowski et al. further discloses the fee is the difference between the original power consumption and the new power consumption multiplied by actual hours of operation, multiplied by a power rate, and multiplied by an air conditioning reduction factor. The hours of operation, the power rate and the air conditioning reduction factor may be determined through negotiation. Other calculations may be used to suit the specific requirements of the end user and the service provider, such as a fee comprising only a portion of the reduction.

From this teaching of Yablonowski et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the monitoring of equipment of Mise to include the fee charge to the user and the payment of electric utility as taught by Yablonowski in order to provide energy saving.

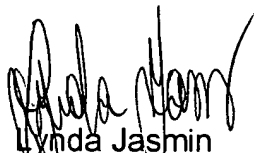
Response to Arguments

6. Applicant's arguments with respect to claims 21-43 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (571) 272-6782. The examiner can normally be reached on Monday- Friday (9:30-6:00) with Thursday Telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin
Primary Examiner
Art Unit 3627